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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/731,342	12/06/2000	Benjamin Wiegand	JBP-529	9185

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Philip S. Johnson, Esq.  
Johnson & Johnson  
One Johnson & Johnson Plaza  
New Brunswick, NJ 08933-7003

EXAMINER

YU, GINA C

ART UNIT	PAPER NUMBER
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1617

DATE MAILED: 03/27/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application N .

09/731,342

Applicant(s)

WIEGLAND ET AL.

Examiner

Gina C. Yu

Art Unit

1617

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on December 12, 2001.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☒ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 6.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

### **DETAILED ACTION**

Receipt is acknowledged of Amendment filed on January 12, 2002. Claims 1-20 are pending. Claim rejection under 35 U.S.C. § 112 has been withdrawn in view of the amendment by the applicants. Claim rejection under § 102 is maintained.

#### ***Claim Rejections - 35 USC § 102***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Herman, Global Cosmetic Industry, vol. 162, n.2, pp. 22 and 24.

Rejection is maintained for reasons of record as indicated in the previous office action dated August 2, 2001.

#### ***Claim Rejections - 35 USC § 103***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

1. Claims 2, 3, 10-17, 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Herman as applied to claim 1 as above, and further in view of Santora et al. (U.S. Pat. No. 6,046,145).

Rejection is maintained for reasons of record.

2. Claims 4-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Herman and Santora et al. as applied to claims 1-3, 10-17, and 20 as above, and further in view of Greenberg et al. (U.S. Pat. No. 4,940,577).

Rejection is maintained for reasons of record.

3. Claims 18 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Herman as applied to claim 1 as above, and further in view of Piechota (U.S. Pat. No. 5,256,396).

Rejection is maintained for reasons of record.

### ***Response to Arguments***

Applicant's arguments filed on December 12, 2001 in response to office action dated August 2, 2001, have been fully considered but they are not persuasive.

#### **1. Rejection over Herman**

Applicants argue that Herman does not anticipate instant claims because the reference fails to disclose "benefit agent". Specifically, applicants note that the carbomer which examiner noted as a benefit agent is used in Herman as a thickener for the composition. Examiner takes the position that the fact that the polymer is referred as a thickener in Herman does not alter its function as a film-forming agent, a benefit agent by applicants' disclosure in specification p. 12, line 12.

#### **2. Rejection over Herman and Santora**

Applicants argue that Herman and Santora fail to provide a routineer to combine the references. Specifically, applicants asserts that Herman merely disclose broad teaching of ringing gel composition without mentioning the use of the composition for depositing benefit agents. Examiner notes that Herman teaches the application of the ringing gel in upscale skin care compositions, which, upon topical administration,

inherently deposits the cosmetic active agents therein on skin. See p. 24, first column, lines 1-4.

Applicants also notes that Santora fails to teach ringing gel. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). The fact that Santora is silent as to the application of its surfactants in ringing gel composition does not necessarily negate the obviousness that a skilled worker would have chosen the known surfactants with specific beneficial cosmetic properties for the surfactants in Herman's ringing gel compositions.

In response to applicant's argument that there would be no reasonable expectation of success even if the references were combinable, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

3. Rejection over Herman and Santora and further in view of Greenberg

Applicants' argument that Greenberg does not cure the deficiencies of Herman and Santora is unpersuasive or moot in view of the above reasons. Applicants' argument that a routineer would not have been motivated to incorporate the ingredients

disclosed in Greenburg into ringing gel or expected that the resulting composition would be effective in depositing skin benefit agents. Again, these arguments attacking the individual reference are unpersuasive because the rejection is based on the combination of all three references.

4. Rejection over Herman in view of Piechota

Applicants argue that Piechota teaches away from ringing gel composition. Applicants specifically refer to the teaching in the reference which refers to the effect of a particular poloxamers in ringing gel formation. Examiner views that the disadvantage of using poloxamers is irrelevant in adding acne agents or antibacterial agents into the ringing gel of Herman for topical use. The specific types of poloxamers referred by Piechota, Poloxomer 407, is neither a required limitation in instant claims or disclosed in Herman.

4. The present invention is viewed as an obvious modification of prior arts. Examiner notes that there is no evidentiary support in the record that shows any unexpected results of combining the well-known ingredients in the art. See MPEP 716.02. Absent such evidence to overcome the obviousness, the rejections are maintained.

***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within

TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gina C. Yu whose telephone number is 703-308-3951.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Minna Moezie can be reached on 703-308-4612. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-4242 for regular communications and 703-308-4242 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1234.

Gina C. Yu  
Patent Examiner  
March 21, 2002

  
MINNA MOEZIE, J.D.  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 1600